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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,368	02/12/2001	John E. Cronin	ipCG-508	4217

7590 07/25/2005

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EXAMINER	
MOONEYHAM, JANICE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,368	CRONIN, JOHN E.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

M

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 25, 2005, wherein:

Claims 36-59 are currently pending;

Claims 1-35 have been cancelled;

Claims 36-59 are new.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2005 has been entered.

Response to Amendment

Claim Objections

3. Claims 48 and 55 objected to because of the following informalities: The applicant claims "allowing a facilitation to select". It appears to be a typo and that applicant meant "allowing a facilitator to select". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 36-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant has identified an invention which requires a user to input information into a computer upon a request for the information and wherein a selection process is performed by a human facilitator or by a vote by the participants. Because the information entered is subjective and the selection process is subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention. The subjective analysis and interpretations of the users do not allow for a useful and concrete result.

5. Claims 37, 46-51 and 53-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims "generating at least one invention map." How is this map generated? What role does the computer have in the generation of the map? The applicant, in the Remarks, directs the Examiner to Figure 12 and the accompanying description on pages 21 and 22. The Examiner has reviewed Figure 12 and the

accompanying description on pages 21 and 22 of the specification and finds that the description would not enable one skilled in the art to make the map without undue experimentation.

6. Claims 50-51 and 57-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has the following language in the claims: "soliciting a plurality of participants." The Examiner is unable to find how this soliciting is performed in the specification and request the applicant direct the Examiner to the portion of the specification where this is described.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claim 36-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

7. In the present case, claims 36-45 only recite an abstract idea. The recited steps of merely requesting information, instructing on concepts, selecting statements and generating a map does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to request information, instruct on concepts, and allow for selection.

There is no technology in claims 36-39 and 41-43.

In claims 40 and 44-45, there is trivial use of a computer. The mere trivial use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In the present case, mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the claim. In this case, the recited steps are directed to receiving and storing data without the computer

being used in the manipulation or processing of the data. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps other than just receiving, storing and outputting data.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. It is not clear now the claimed invention as described in the disclosure of this application would be useful or tangible to one in the industry.

8. Claims 36-59 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility. A person of ordinary skill in the art would not immediately appreciate how the invention operates to facilitate conception of at least one invention. The claim language comprises requesting information, instructing on the concepts, selecting statements and generating a map using some or parts of the information. Thus, the claimed invention does not produce the useful result of facilitating the conception of at least one invention.

Claims 36-59 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

9. Claims 36-59 also do not produce a concrete result. The claimed invention repeatedly requests at least one participant to enter information and generates a map using at least some of this information. It appears that the selecting step is performed

by a human being (facilitator) or is performed by the participants voting on the selection. Thus, the invention does possess repeatability and/or implementation without undue experimentation. The subjective analysis and interpretation of information by a human being is not reproducible and thus the invention does not provide a concrete result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton (US Patent No. 6,101,490) (hereinafter referred to as Hatton).

Hatton discloses a method for facilitating conception (*creating new ideas for solving problems; col. 2, lines 48-49, the invention is a high level computer program that creates new ideas and solves a broad range of problems*) which accepts input and provides output (*Figure 5 Problem statement Goal directive entered into the computer interface with answers being output from the interface*), requesting and accepting input comprising data (*Fig. 5 – problem statement, Goal statement; Fig. 7, receiving input statement, col. 1, lines 64-66, col. 7, lines 45-51, requires two input statements – a problem statement and a goal declaration*).

While Hatton discloses a computerized idea generator and problem solver (*col. 1, lines 29-33*), Hatton does not explicitly show the data to be a mess statement, a data

statement relating to the mess statement, problem statements relating to the data statements, elements relating to the problem statements, mess statements and/or data statements, limitations of problem-element-solution combinations, solutions to the limitations and elements conceived using visual, tactile or olfactory stimulus.

However, these differences are only found in the nonfunctional descriptive material not functionally involved in the steps recited. The applicant's invention is a method of requesting information by way of prompting a user to enter the information. The requesting/prompting and accepting input data would be performed the same regardless of the data in the request or the response. The data is not functionally interrelated with the steps. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentablility, see *In re Gulack,* 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983; *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person or ordinary skill in the art to use data having any type of content because such data does not functionally relate to the steps or the structure of the method or apparatus claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Hatton does not explicitly disclose that the invention is for facilitating the conception of an invention. However, Hatton does disclose creating new ideas for solving problems (*col. 1, lines 64-66*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the method of Hatton of creating ideas for solving problems to facilitate conception of inventions since the invention of Hatton is intended to be used by everyone who has the need to create new ideas or solve problems and the invention can create new ideas and solve a broad range of problems which could include ideas to problems that later develop into inventions.

11. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton as applied to claim 36 above, and further in view of Smith (US 5,662,478) (hereinafter referred to as Smith).

Hatton does not disclose generating a map.

However, Smith discloses generating at least one invention map showing the at least one solution (*see the Figure associated with patent*).

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Hatton the teachings of Smith since the map reduces discord by providing a tool which enables the members of the group to estimate their present position in the flow process because the process of generating problem solving ideas is very analogous to the expeditionary process.

12. Claims 38-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilliam et al (US 5,878, 214) (hereinafter referred to as Gilliam) in view of Smith (US Patent 5,662,478).

Gilliam discloses a method (*provides a formal innovative problem solving methodology, col. 3, lines 1-2*), system and medium (*software, col. 4, lines 11-13*) for facilitating conception (*a computerized system for true creative problem solving which helps lead participants through the problem solving process and to innovative solutions, col. 2, lines 55-61*), comprising:

a computer system with a processor and a storage device in communication with the processor and computer executable instructions for controlling the processor in a manner so as to manipulate a plurality of data (*Figure associated with patent (10) each participant of the group is provided with a computer; (20) participants are linked together through a computer network; col. 3, line 45 thru col. 4, line 26 Pentium MMX processor, RAM storage*)

requesting a participant to input data (*Figure see (60), participants engage in springboarding activity and responses are gathered (70) elaborations and builds are gather from all participants, see col. 4, lines 54-65 gathering responses to the problem – known as springboarding, gathering comments about and elaborations upon the responses, see also, col. 5, lines 8-18; (100) col. 5, lines 56-64 gathering action oriented ideas*);

manipulating data (broadly construed to be storage and retrieval of data since applicant has not identified what is meant by manipulation in the specification) (*col. 5, lines 13-15 the accumulation of feedback is displayed on all participant's computer monitors, just as the a list of response was generated and displayed in block 60; col. 6, line 63 thru col. 7, line 5 folders*);

selecting data from the input data (*(80) of the Figure, col. 5, lines 24-49 polling; resources may vote yes or no, (90) beginning ideas are selected by client based on results of poll; (110) a number of action ideas is selected to become emerging ideas. The selection process can be accomplished through the use of polling or through a less formal process (130) client selects one or more emerging ideas as possible solutions to the problem)*;

displaying a picture that shows at least some of the data (*col. 5, lines 42-49 results of pool may be displayed in a number of matrix, graphical or tabular forms including bar charts, line charts, pie charts, two and three dimensional graphs and tables*);

providing at least three input fields (see Figure *(60) participants engage in springboarding activity and responses are gathered (70) elaborations and builds are gathered from all participants (100) action oriented ideas are gathered)*.

Gilliam discloses a facilitator who acts as a process planner and mediator to move the problem solving process along and the facilitator being both an advisor and an enabler of the process (col. 4, lines 30-39). Gilliam does not explicitly disclose instructing at least one participant on concepts and Gilliam does not explicitly disclose a map.

However, Smith discloses instructing at least one participant on concepts (*col. 3, lines 63-66 there is provided a method for training a facilitator to enable a group of people to execute one or more creative thinking sessions to generate ideas for solving; col. 4, lines 26-27 the role of the facilitator (known as the guide) is to implement the*

process, explain the rules; col. 4, lines 37-38 the guide is taught to instruct the group on concepts) and a map (*See the Figure; col. 1, lines 59-61 the invention comprises providing a map*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the innovative methodology of Gilliam the training and map of Smith since the map reduces discord by providing a tool which enables the members of the group to estimate their present position in the flow of the process and to provide an expeditionary path and to provide training for the facilitator in order for the facilitator to be able to relate the concepts to the members of the group and to lead the group in a continuous flow of increasingly creative thinking sessions.

Smith describes a situation to be investigated as the mess and a mess being a set of interconnected problems, challenges, issues, opportunities, expectations and ideas and that the facilitator/guide is taught how to lead the group in analyzing the mess, expanding existing problems into broader purposes, exploring obstacles and desired outcomes and leading the group in discovering information relating to the mess (*col. 4, line 62 thru col. 5, line 3*). However, neither Gilliam nor Smith explicitly show the a data statement relating to the mess statement, problem statements relating to the data statements, elements relating to the problem statements, mess statements and/or data statements, limitations of problem-element-solution combinations, solutions to the limitations and elements conceived using visual, tactile or olfactory stimulus.

However, these differences are only found in the nonfunctional descriptive material not functionally involved in the steps or system recited. The applicant's

invention is a method, medium and system for requesting information by way of prompting a user. The requesting/prompting and accepting input data would be preformed the same regardless of the data text of the prompt/request and the data in the response to the request/prompt. The language is not functionally interrelated with the steps or structure. Therefore, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentablility, see *In re Gulack,* 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983; *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person or ordinary skill in the art to use data having any type of content because such data does not functionally relate to the steps or the structure of the method or apparatus claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Gilliam does not explicitly disclose that the invention is for facilitating the conception of an invention. However, Gilliam does disclose a computer-based innovative problem solving methodology col. 2, line 66 thru col. 3, line 7)

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the problem solving methodology of Gilliam to facilitate conception of inventions since the invention of Gilliam satisfies the need for a computerized group decision support system, provides a formal innovative problem solving methodology, allows participation by large numbers of individuals, permits the participants to be in

multiple locations, and encourages parallel problem solving, all of which would aid in the conception of an invention.

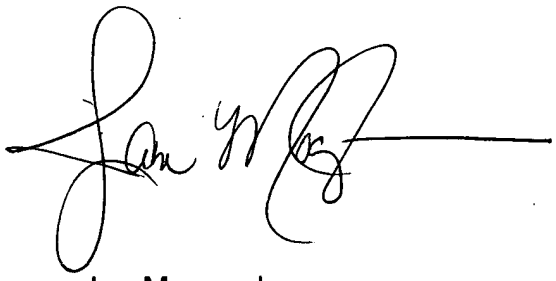
Response to Arguments

Applicant's arguments with respect to claims 36-59 have been considered but are moot in view of the new ground(s) of rejection. Applicant has cancelled all of the previous claims and added all new claims. The applicant has only provided arguments as to the new claims but not to the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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